UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,141	10/31/2003	James Howard Drew	03-8012	3441

25537 7590 12/16/2011

VERIZON
PATENT MANAGEMENT GROUP
1320 North Court House Road
9th Floor
ARLINGTON, VA 22201-2909

EXAMINER	
STERRETT, JONATHAN G	

ART UNIT	PAPER NUMBER
3623	

NOTIFICATION DATE	DELIVERY MODE
12/16/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@verizon.com

Office Action Summary	Application No.	Applicant(s)	
	10/699,141	DREW ET AL.	
	Examiner	Art Unit	
	JONATHAN G. STERRETT	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 December 2011*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *1,3 and 5-34* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☒ Claim(s) *29-34* is/are allowed.

7)☒ Claim(s) *1,3 and 5-28* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/GB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This **Final Office Action** is responsive to 7 December 2011. Currently **Claims 1, 3 and 5-34** are pending.

Response to Arguments

2. The applicants' arguments have been fully considered but are not persuasive.

The applicant argues that the claims are statutory re 35 USC 101.

The examiner respectfully disagrees.

In the decision of October 13, 2011, the Board stated:

> Appellants then assert that "applying linear regression techniques utilizing a computing system" renders the process statutory (App. Br. 20-21; Reply Br. 2-3). However, the linear regression is an abstract idea that can be performed purely as mental steps, and "utilizing a computing system" to perform the linear regression is a field-of-use limitation to a particular technological environment insufficient to render it statutory. Moreover, the phrase "utilizing a computing system" is extremely broad, as arguably a user could just use the computing system in a *de minimis* manner, such as a like a calculator, while mentally performing the bulk of the linear regression. In such a case, "utilizing a computer system" in the linear regression would be no more than an extra-solution activity that is disfavored in *Bilski*.
>
> Insofar as our rationale differs from that set forth by the Examiner, we denominate it a new ground under 37 C.F.R. § 41.50(b).

The applicant has amended claim 1 to read:

1. (Currently amended) A ~~computer implemented~~ method of determining comparable performance measures for employees having differing task assignments, comprising:

storing employee task data in a database of a computing system, wherein said employee task data includes a number of tasks completed and an amount of time spent on at least one completed task;

generating, in a computer having a processor and a memory, sets of task scores based on a selected model design of task assignments utilizing said employee task data;

selecting a centralized composite design as said model design;

performing a plurality of evaluations of said sets of task scores, said evaluations assigning productivity scores to said sets of task scores,

analyzing said productivity scores to determine productivity parameters, wherein analyzing said productivity scores comprises using said processor, according to instructions stored in said memory, to applying linear regression techniques to said productivity scores utilizing said computing system; and

applying said productivity parameters to employee task scores for said employees to obtain said performance measures for said employees.

The first amended limitation "generating, in a computer having a processor and a memory, sets of task scores" could be performed in a *de minimis* manner, e.g. as with a calculator, while performing the bulk of the step, i.e. the generating being based upon a selected model design using the employee task data. Furthermore, the limitation "using said processor, according to instructions stored in said memory, to apply linear regression techniques" can similarly be applied in a *de minimis* manner to perform the regression analysis. Claim 22 recites similar limitations as claim 1 and is similarly not statutory.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3 and 5-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 22 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without

the use of a particular apparatus. Thus, **Claims 1 and 22** are non-statutory since it they, as a whole, lack a tie to a particular machine. Dependent **Claims 3 and 5-21 and 23-28** are not statutory at least for the reasons given above for **Claims 1 and 22**.

Allowable Subject Matter

Claims 29-34 are allowed.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGS 12-12-2011

/Jonathan G. Sterrett/

Primary Examiner, Art Unit 3623